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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FISH & RICHARDSON P.C.
3300 DAIN RAUSCHER PLAZA
60 SOUTH SIXTH STREET
MINNEAPOLIS, MN 55402

EXAMINER

GREEN, BRIAN

ART UNIT PAPER NUMBER

3611

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,851

Applicant(s)

GENTRY, MARY E.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 14-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/11/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to an apparatus for displaying, classified in class 40, subclass 768.
- II. Claims 14-20, drawn to a method of identifying an object in a frame, classified in class 29, subclass 428.

The inventions are distinct, each from the other because of the following reasons:

Inventions I. and II. are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as providing a block of wood, carving a cardholder out of a portion of the block of wood, carving a picture frame out of the rest of the block of wood, the picture frame and cardholder being formed from a single piece of wood, placing a card within the cardholder, and writing a desired message on the card which is within the cardholder.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Greg Gardella on Aug. 11, 2004 a provisional election was made without traverse to prosecute the invention of Group II,

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claims 14-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-13 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the multiple cavities and multiple cards defined in claim 18 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because on line 2 the word “invention” is used which is improper. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 14-20 are objected to because of the following informalities: In claim 14, line 4, “it’s” should apparently be “the” in order to show that the rear side is the same as the rear side defined in line 2. In claim 18, lines 2-3, “the respective cavities” should be “respective cavities” since there is no antecedent basis for “the respective cavities”. In claim 20, line 3, “the message” should apparently be “the information” since there is no antecedent basis for “the message”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, lines 3 and 8, claim 16, lines 3 and 7, and claim 19, line 1, “the frame” is indefinite since it is not clear whether the applicant is referring to the frame defined in claim 14, line 1 or the picture frame defined in claim 14, line 2. In claim 14, line 5, “an optional second viewing window” is indefinite since it is not clear whether the applicant is positively claiming the second viewing window because of the word “optional” appearing before “second viewing window”. In claim 18, line 2 is indefinite since it is not clear whether the multiple cards include the card defined in claim 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-17, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hord (U.S. Patent No. 4,856,213) in view of Sato et al. (U.S. Patent No. 5,518,274).

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Hord shows in figures 1-4 a picture frame (12) having a front side and rear side, the front side having a first viewing window (covered by glass 22) and a cardholder (30) secured to the rear side. Hord discloses the idea of sliding a video cassette (42) and box (40) into the cardholder. The applicant defines in claim 14 that the window is "optional" so the examiner has taken the position that the cardholder does not have to have the window in it. Hord does not disclose attaching a card to the video cassette/box and transcribing information on the card. Sato et al. shows in figures 7-9 the idea of attaching a card (12) onto a video cassette and transcribing information on the card, see column 1, lines 39-65. In view of the teachings of Sato et al. it would have been obvious to one in the art to modify Hord by attaching an index card to the video cassette and transcribing information on the card since this would allow information contained on the tape of the cassette to be clearly indicated. In regard to claim 15, Hord discloses that the object is a photograph, see column 1, lines 59-61. In regard to claim 16, Hord shows in figures 2-4 that the cardholder includes a mounting portion (32), an offset portion (34) and a cavity (the open area that receives the video cassette). In regard to claim 17, Hord shows in figure 2 an extension (46). In regard to claim 20, Sato et al. shows that the card (12) is folded as broadly defined. When the card is folded some of the information would be concealed depending upon the viewing angle.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hord (U.S. Patent No. 4,856,213) in view of Sato et al. (U.S. Patent No. 5,518,274) as applied to claim 14 above and further in view of Gaddy et al. (U.S. Design Patent 392,473).

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Hord in view of Sato et al. disclose the applicant's basic inventive concept except for providing multiple cavities and cards. Gaddy et al. shows in figures 1-4 the use of a tape holder for multiple tapes. In view of the teachings of Gaddy et al. it would have been obvious to one in the art to modify Hord by providing multiple cavities since this would allow a plurality of cassettes to be held by the picture frame. Each of the cassettes would include a card (12) as taught by Sato et al.

Claims 14-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791).

Plotkin et al. shows in figures 1-5 a picture frame (14) having a front side and rear side, the front side having a first viewing window (covered by glass 18) and a picture (42) and other authenticity type information secured to the rear side. Plotkin et al. does not disclose attaching a cardholder on the rear side, transcribing information on a card, and inserting the card into the cardholder. Leeland shows in figures 1-5 a cardholder (3) attached to a card, a card (the autograph card) having information written thereon, and inserting the card into the cardholder. Leeland shows in figure 1 that the cardholder includes a second viewing window. In view of the teachings of Leeland it would have been obvious to one in the art to modify Plotkin et al. by attaching a cardholder to the rear of the frame, transcribing information on the card, and inserting the card into the cardholder since this would provide additional authenticity to the displayed object and would further enhance the gift presentation and value of the display. In regard to claim

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15, Plotkin discloses that the object is a photograph, see column 2, lines 65-67. In regard to claim 16, Leeland shows in figures 1-5 that the cardholder includes a mounting portion (7), an offset portion (the front portion which includes 4,5) and a cavity (the open area that receives the autograph card). In regard to claim 17, Leeland shows in figure 5 an extension (6).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791) as applied to claim 14 above and further in view of Stenger (U.S. Patent No. 3,734,155).

Plotkin et al. in view of Leeland disclose the applicant's basic inventive concept except for providing multiple cavities and cards. Stenger shows in figure 1 the use of a card holder for multiple cards. In view of the teachings of Stenger it would have been obvious to one in the art to modify Plotkin et al. by providing multiple cavities since this would allow a plurality of cards to be held by the picture frame, i.e. multiple autograph cards when multiple people are shown in the photograph.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotkin et al. (U.S. Patent No. 5,526,597) in view of Leeland (U.S. Patent No. 1,251,791) as applied to claim 14 above and further in view of Shevin et al. (U.S. Patent No. 4,069,606).

Plotkin et al. in view of Leeland disclose the applicant's basic inventive concept except for providing a folding card. Shevin et al. shows in figure 1 the use of a card (22) that is folded and inserted into a holder. In view of the teachings of Shevin et al. it would have been obvious to one in the art to modify Plotkin et al. by folding the card since this

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would allow a larger card to be used enabling more information to be placed onto the card. When the card is folded some of the information would be concealed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Smith et al., Smith, and Fargo teach the use of cardholders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (703) 308-1011. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (703) 308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
Aug. 23, 2004